

REMARKS/ARGUMENTS

Reconsideration of the present application, as amended, is respectfully requested.

Since the present amendment raises no new issues for consideration and, in any event, places the present application in better condition for consideration on appeal, it is respectfully requested that this amendment be entered under 37 C.F.R. § 1.116 in response to the last Office Action dated July 9, 2008, which made final rejections as to the pending claims.

A. Status of the Claims

As a result of the present amendment, claims 1-12 and 14-16 are presented for continued prosecution. Claim 13 has been canceled by this amendment.

It is submitted that the current amendment should be entered in response to the final Office Action since only claim 13 has been canceled and no further search or consideration is required.

B. Allowable Subject Matter

The Examiner indicated that claims 15 and 16 would be allowable if rewritten in independent form to include the limitations of the base and intervening claims.

C. Claim Rejections under 35 U.S.C. §112, second paragraph

Claim 13 had been rejected as indefinite. Claim 13 has been canceled. It is noted that the subject matter of claim 13 is recited in claim 5.

D. The Office Action

In the Response to Arguments portion of the Office Action beginning in section 11, the Examiner cited MPEP §2111.01 for the proposition that claims are given their broadest reasonable interpretation during examination. Presumably, the Examiner has relied on this section of the MPEP to broadly construe the scope of the claims in comparison with the prior art.

Applicant is fully aware of MPEP §2111.01 and the relevant case law. However, Applicant would like to stress other portions of MPEP §2111.01 which were not specifically cited by the Examiner.

"This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)" (emphasis added).

"[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (*en banc*) (emphasis added).

"The ordinary and customary meaning of a term may be evidenced by a variety of sources, including "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." *Phillips v. AWH Corp.*, 415 F.3d at 1314, 75 USPQ2d at 1327.

While it is true that the claims are broadly interpreted during examination, MPEP §2111.01 explains that the claims must be given their plain meaning as understood by those in the art. Thus, Applicant courteously reminds the Examiner that the broad interpretation given during examination must be consistent with the plain meaning of the claims that would be given by the skilled artisan.

E. Claim Rejections under 35 U.S.C. §102 based on Deng and Nakamura

Claims 1, 3, 4, 6-10 and 14 had been rejected as being anticipated by Deng (U.S. 6,076,720). Claims 1, 2, 4, 5 and 13 had been rejected as being anticipated by Nakamura (U.S. 5,497,931).

In order to maintain an anticipation rejection under 35 U.S.C. §102, the prior art must disclose each and every element of the rejected claims with sufficient clarity to prove its existence in the prior art. Applicant respectfully submits that Deng and Nakamura do not anticipate the claimed invention for at least the following reasons.

Specifically, as brought out in more detail below, one of the differences between the claimed invention compared to Deng and Nakamura is that claim 1 recites that mobile plate 7 slides "between" ejection head 5 and striker 6. Any element of Deng and Nakamura which can be considered to be a mobile plate does not slide "between" an ejection head and a striker, because the ejection head and striker of Deng and Nakamura abut each other and are always in mutual contact. More detail is provided below.

1. Deng does not teach or suggest a mobile plate that slides to a position between the ejection head and the striker as recited in claim 1

Claim 1 of the present application recites that mobile plate 7 slides "between" ejection head 5 and striker 6. This aspect of the invention can be seen, for example, in Figures 2 and 8. As illustrated therein, mobile plate 7 is inserted between ejection head 5 and striker 6 to punch staples/nails of a thin width. Figure 8 can be compared with Figures 5 and 6. Figures 5 and 6 illustrate mobile plate 7 after it is moved from its operative position in Figure 8 (e.g., between ejection head 5 and striker 6) into its rest position in Figures 5 and 6. Staples/nails having a thick width can be punched in this manner because mobile plate 7 has been moved to its rest position. Thus, by comparing Figure 8 with Figures 5 and 6, it is shown that mobile plate 7 moves between the ejection head 5 and striker 6, and such movement allows the stapler to punch both thin and thick staples.

Applicant previously argued that adjusting member 30 of Deng does not slide between ejection head 122 and striker 112. This argument was not convincing. In a telephone discussion with the undersigned on July 23, 2008, the Examiner clarified that the reasons for the rejection are located in the first paragraph on page 3 of the current Office Action. In this section of the Office Action, the Examiner stated that pin expander 244 of Deng vertically slides into opening 322 in the central body of slider 30 and across an opening in the middle of slider 20. Thus, it appears that the Examiner has equated pin expander 244 of Deng with the claimed mobile plate 7, and has stated that movement of pin expander 244 into the central body of slider 30 is a movement between ejection head 122 and striker 112 as claimed.

Applicant respectfully disagrees with the rejection. First, it should be noted that the Examiner has inadvertently interchanged some of the reference numbers of Deng. For example, the Examiner refers to "slider 24" and "mobile plate 30" in lines 1 and 2 on page 3 of the Office Action, but refers to "mobile plate 24" and "slider 30" in line 8. For clarification, Applicant notes that Deng specifically teaches that element 24 is the sliding plate, while element 30 is the adjusting member. However, in either event, neither element 24 nor element 30 of Deng move between ejection head 122 and striker 112 as further explained below.

Furthermore, Applicant notes that pin expander 244 of Deng, which appears to have been cited to teach the claimed mobile plate 7, is actually just a small notch located in sliding plate 24

(see Figure 1 of Deng). Thus, it should be clarified that pin expander 244 and sliding plate 24 of Deng are connected and both move in the same manner.

Still further, Applicant notes that the Examiner did not provide a reference number to identify what is being cited as the ejection head of Deng. This is an important omission. The ejection head must be accurately identified, because claim 1 of the present application recites that mobile plate 7 slides between ejection head 5 and striker 6. For completeness, Applicant notes that element 122 of Deng is the ejection head. Element 122 is the ejection head because it is understood in the art that an ejection head is the front wall against which the staples are pushed by a spring or the like. This is element 122 of Deng.

Turning back to the merits of the rejection, the Examiner stated that pin expander 244 (which is a component of sliding plate 24) vertically slides into opening 322 in the central body of slider 30 (which is actually adjusting member 30). Applicant respectfully submits that this aspect of Deng does not anticipate claim 1. As shown in Figures 1, 3 and 5 of Deng, all of the components of Deng cited by the Examiner, namely, pin expander 244, sliding plate 24, and adjusting member 30, are located to the left of ejection head 122 and ejector 112. In other words, there is nothing "between" ejection head 122 and striker 112 of Deng. Ejection head 122 and striker 112 of Deng are always in mutual contact. This mutual contact can be seen in Figure 5 of Deng, where it is evident that ejection head 122 and striker 112 are both vertically oriented elements, and striker 112 slides against the surface of ejection head 122 when staples are punched. There is no space "between" ejection head 122 and striker 112. Thus, a mobile plate cannot slide between these two elements.

Applicant respectfully submits that the Examiner has not met the burden of citing a reference which teaches each and every element of the claimed invention as required to maintain an anticipation rejection under §102. Particularly, Deng does not teach or suggest a mobile plate that slides between an ejection head and a striker as recited in claim 1. It is therefore urged that the rejection should be withdrawn.

The Examiner is invited to contact the undersigned to expedite prosecution if she has any questions or comments.

2. Nakamura does not teach or suggest a mobile plate that slides to a position between the ejection head and the striker as recited in claim 1

Claim 1 of the present application recites that mobile plate 7 slides "between" ejection head 5 and striker 6.

Applicant previously argued that lock plate 67 of Nakamura does not slide between guide plate 104 and striker 32. The Examiner was not convinced. In section 13 of the Office Action, the Examiner rejected claim 1 stating that plate 67 of Nakamura moves between striker 32 and ejection head 62 (element 62 was determined to be the ejection as indicated in footnote 4 on page 7 of the Office Action).

Applicant respectfully disagrees with the rejection. First, Applicant notes that element 32 cited by the Examiner to be the striker is actually the "elevating frame 32" of Nakamura (see col. 4, lines 24-27). The striker is "follow blade 36" as illustrated in Figures 1 and 2 (see col. 4, lines 24-27). Applicant respectfully reminds the Examiner that the broad interpretation given during examination must be consistent with the plain meaning that would be given by the skilled artisan as required by MPEP §2111.01. The skilled artisan considers follow blade 36 to be a striker, not elevating frame 32.

Second, Applicant respectfully disagrees with the Examiner's determination that element 62 of Nakamura is the ejection head. Element 62 is specifically described by Nakamura as being the "cover assembly 62" for housing operation buttons 73 (see col. 5, lines 6-7 of Nakamura). The ejection head of Nakamura is "element 104", which is clearly described in col. 6, lines 8-9 as being the component which provides a path for guiding punched staples downward. It is understood in the art that an ejection head is the front wall against which the staples are pushed by a spring or the like. Thus, the ejection head is element 104 of Nakamura, not element 62. Any determination otherwise would be contradictory to the meaning understood by those skilled in the art.

Third, the Examiner cited element 33a in line 1 on page 7 of the Office Action. However, Nakamura does not disclose element 33a. It was clarified by telephone with the undersigned on July 23, 2008 that the Examiner was referring to element 33a which appears in a commonly owned patent (Nakamura 5,639,007). A similar element appears in Nakamura, albeit that the reference number 33a is not provided.

Turning now to the merits of the rejection, Applicant submits that lock plate 67 does not move "between" ejection head 104 and follow blade 36 (or, for arguments sake, elevating frame 32 as cited by the Examiner). As shown in Figures 1 and 2 of Nakamura, lock plate 67 is located to the left of ejection head 104 and to the left of follow blade 36 (or, for arguments sake, to the left of elevating frame 32 as cited by the Examiner). In other words, there is nothing "between" ejection head 104 and follow blade 36 of Nakamura. Ejection head 104 and follow blade 36 of Nakamura are always in mutual contact. This mutual contact can be seen in Figure 2 of Nakamura, where it is evident that ejection head 104 and follow blade 36 are both vertically oriented components, and follow blade 36 slides against the surface of ejection head 104 when staples are punched. There is no space "between" ejection head 104 and follow blade 36. Thus, a mobile plate cannot slide between these two elements.

Applicant respectfully submits that the Examiner has not met the burden of citing a reference which teaches each and every element of the claimed invention as required to maintain an anticipation rejection under §102. Particularly, Nakamura does not teach or suggest a mobile plate that slides between an ejection head and a striker as recited in claim 1. It is therefore urged that the rejection should be withdrawn.

The Examiner is invited to contact the undersigned to expedite prosecution if she has any questions or comments.

3. Deng does not teach or suggest moving a slider to slide a mobile plate

Claim 1 recites moving slider 8 to slide mobile plate 7 in the main body of the stapler. This aspect of the invention is illustrated, for example, in Figure 1 which shows that slider 8 can be grabbed by a user to slide mobile plate 7 in an upward and downward direction. Thus, two elements move, slider 8 and mobile plate 7.

Applicant previously argued that adjusting member 30 of Deng does not slide in this manner. This argument was not convincing. In the first paragraph of section 12 of the Office Action, the Examiner stated that plate 30 of Deng slides against a surface of slider 24, and cited a dictionary to describe the meaning of the word slide in support of the rejection. The cited definition of slide was "to move over a surface while maintaining smooth, continuous contact".

Applicants respectfully disagree with the rejection. As described by Deng, element 24 is the sliding plate and element 30 is the adjusting member. Figure 1 of Deng shows that control

knob of sliding plate 24 is grabbed by a user to move sliding plate 24 upward and downward. This upward and downward movement pushes sliding plate 24 against adjusting member 30 to flex pressing strips 32,26 of adjusting member 30 in a left and right direction.

The Examiner equated sliding plate 24 of Deng with the claimed slider 8, and adjusting member 30 of Deng with the claimed mobile plate 7. However, these elements of Deng do not teach the limitation "moving the slider 8 so that the mobile plate 7 can slide" as recited in claim 1. True, sliding plate 24 of Deng moves. However, in contrast to the mobile plate of claim 1, adjusting member 30 of Deng does not slide, i.e. "to move over a surface while maintaining smooth, continuous contact". Rather, the element which "moves over a surface" is sliding plate 24 of Deng, not adjusting member 30. Adjusting member 30 is simply pushed back and forth, flexes, bends, springs, etc. This is the reason why "sliding plate 24" has been called a "slider" by Deng, not element 30. Thus, even taking into account the dictionary definition cited by the Examiner, Applicant nonetheless respectfully submits that adjusting member 30 of Deng does not slide.

Applicant respectfully submits that the Examiner has not met the burden of citing a reference which teaches each and every element of the claimed invention as required to maintain an anticipation rejection under §102.

4. Deng does not teach or suggest a mobile plate that slide parallel to the run direction of the striker

Claim 3 recites that mobile plate 7 slides in a direction substantially parallel to the run direction of the striker 6. This is the upward and downward direction illustrated in Figure 1 of the application.

Applicant previously submitted this argument, but the Examiner was not persuaded. In the second paragraph of section 12 of the Office Action, the Examiner stated that element 30 of Deng moves parallel to the travel plane of striker 112. Applicant respectfully disagrees.

Similar to the arguments presented in section 3 above, adjusting member 30 of Deng is pushed by sliding plate 24 to move back and forth, flex, bend, etc. This movement is not parallel to the run direction of striker 112 (i.e. upward and downward). Instead, adjusting member 30 of Deng flexes back and forth in the left and right direction of Figure 1 of Deng, which is perpendicular to the run direction of striker 112. Moreover, adjusting member 30 of Deng is

fixed to ejection head 122 (see the upper portion of Figure 3 of Deng) and does not move upward or downward at any time.

Applicant respectfully submits that the Examiner has not met the burden of citing a reference which teaches each and every element of the claimed invention as required to maintain an anticipation rejection under §102.

F. Fees

This Response is being filed within the shortened statutory period for reply. No fee is believed to be due. If, on the other hand, it is determined that fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275. Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

G. Conclusion


In view of the actions taken and arguments presented, it is respectfully submitted that each and every one of the matters raised by the Examiner has been addressed by the present amendment and that the present application is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By: _____


Timothy D. Meade
Registration No. 55,449

LUCAS & MERCANTI, LLP
475 Park Avenue South
New York, NY 10016
Phone: 212-661-8000
Fax: 212-661-8002

CERTIFICATE OF ELECTRONIC TRANSMISSION
I hereby certify that this document is being electronically
transmitted to the Commissioner for Patents via EFS-Web on
October 9, 2008.

LUCAS & MERCANTI, LLP

By: 
Timothy D. Meade